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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/689,952	10/12/2000	Jerry Pelletier	21715/1010	7855

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EXAMINER
KAM, CHIH MIN

ART UNIT	PAPER NUMBER
1653	

DATE MAILED: 09/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/689,952	PELLETIER ET AL.	
	Examiner	Art Unit	
	Chih-Min Kam	1653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-52 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) 1-52 are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U. S. C. 121:

I. Claims 1-10, drawn to a method of identifying a compound that is active on a polypeptide comprising the amino acid sequence of SEQ ID NO:16 by detecting the binding of the candidate compound to the polypeptide, classified in class 514, subclass 2, and class 435, subclass 7.1.

II. Claims 11-20, drawn to a method of identifying a compound that is active on a polypeptide comprising the amino acid sequence of SEQ ID NO:16 by detecting the effect of the candidate compound to the binding of the first polypeptide comprising SEQ ID NO:16 with the second polypeptide comprising page 77ORF104, classified in class 514, subclass 2, and class 435, subclass 7.1.

III. Claim 21, in part, drawn to an agonist or antagonist of the activity of a DnaI polypeptide, classified in class 514, subclass 2, and class 435, subclass 7.1.

IV. Claim 21, in part, drawn to an agonist or antagonist of the activity of a gene encoding the DnaI polypeptide, classified in class 536, subclass 23.7, and class 435, subclass 7.1.

V. Claim 22, drawn to a method of identifying a compound that is active on a DnaI polypeptide by contacting the compound with cells expressing a polypeptide comprising SEQ ID NO:16, and detecting the DnaI activity in the cell, classified in class 514, subclass 2, and class 435, subclass 7.1.

VI. Claims 23-25, in part, drawn to a method of making an antibacterial compound, comprising determining whether the compound is active on a polypeptide comprising SEQ ID NO:16, synthesizing the compound having antibacterial effect, classified in class 514, subclass 2, and class 435, subclass 7.1.

VII. Claims 23-25, in part, drawn to a method of making an antibacterial compound, comprising determining whether the compound is active on a gene encoding the polypeptide comprising SEQ ID NO:16, synthesizing the compound having antibacterial effect, classified in class 536, subclass 23.7, and class 435, subclass 7.1.

VIII. Claims 26-33 and 35, in part, drawn to a method of inhibiting bacteria or treating a bacterial infection in an animal, comprising contacting the bacteria with a compound or administering to the animal a compound that is active on a polypeptide comprising SEQ ID NO:16, classified in class 514, subclass 2, and class 424, subclass 9.1.

IX. Claims 26-33 and 35, in part, drawn to a method of inhibiting bacteria or treating a bacterial infection in an animal, comprising contacting the bacteria with a compound or administering to the animal a compound that is active on a gene encoding the polypeptide comprising SEQ ID NO:16, classified in class 536, subclass 23.7, and class 424, subclass 9.1.

X. Claim 34, drawn to a method of prophylactic treatment to prevent bacterial infection, comprising contacting an indwelling device with a compound that is active on a polypeptide comprising SEQ ID NO:16 before its implantation into a mammal, classified in class 514, subclass 2, and class 435, subclass 7.1.

XI. Claims 36 and 37, drawn to a method of diagnosing in an individual an infection with Staphylococus aureus comprising determining the presence of a polypeptide comprising SEQ ID NO:16 using the antibody, classified in class 424, subclass 9.1, and class 530, subclass 387.1.

XII. Claims 38 and 39, drawn to a method of diagnosing in an individual an infection with Staphylococus aureus comprising determining the presence of a nucleic acid encoding a polypeptide comprising SEQ ID NO:16 using a nucleic acid probe that hybridizing with SEQ ID NO:1, classified in class 536, subclass 23.7, and class 424, subclass 9.1.

XIII. Claims 40-43 and 52, drawn to a polynucleotide comprising SEQ ID NO:17, a nucleotide sequence related to SEQ ID NO:1, or a sequence encoding SEQ ID NO:16, or a composition comprising a nucleic acid encoding bacteriophage 77ORF104 and a nucleic acid comprising SEQ ID NO:17, classified in class 536, subclass 23.7.

XIV. Claims 44-49 and 51, drawn to a polypeptide related to SEQ ID NO:16, or a composition comprising a bacteriophage 77ORF104 polypeptide and a polypeptide comprising SEQ ID NO:16, classified in class 530, subclass 350, and class 514, subclass 2.

XV. Claim 50, drawn to an antibody specific for a polypeptide of SEQ ID NO:16, classified in class 530, subclass 387.1.

Should Group I or II be elected, applicant is required to select one detecting process from claims 3-8 or 13-18, one type of compound from claims 9-10 or 19-20 because each type of compound is structurally different entity and has different chemical and physical properties, and

each detecting process utilizes different material and different measurement, thus they are patentably distinct. This is not species election.

Should Group VI or VII be elected, applicant is required to select one type of compound from claims 24-25 because each type of compound is structurally different entity and has different chemical and physical properties, thus they are patentably distinct. This is not species election.

Should Group VIII or IX be elected, applicant is required to select one type of compound from claims 29-30 or 32-33, and an in vitro or in vivo method from claims 27-28 because each type of compound is structurally different entity and has different chemical and physical properties, and the in vitro and in vivo method has different method steps and different outcome, thus they are patentably distinct. This is not species election.

2. The inventions are distinct, each from the other because of the following reasons:

The methods of Inventions I, II and V-XII are patentably distinct each from the other because they have different method steps, utilize different materials and have different outcomes.

The product of Invention III and the methods of Invention VI, VIII and X are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the methods of Inventions VI, VIII and X are alternative processes of use the product of Invention III.

The product of Invention IV and the methods of Invention VII and IX are related as product and process of use. The inventions can be shown to be distinct if either or both of the

following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the methods of Inventions VII and IX are alternative processes of use the product of Invention IV.

The product of Invention XIV and the methods of Invention I, II and V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the methods of Inventions I, II and V are alternative processes of use the product of Invention XIV.

The product of Invention XIII and the method of Invention XII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the product of Invention XIII can be used for making probes in northern or southern hybridization.

The product of Invention XV and the method of Invention XI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the product of Invention XV can be used for western blotting.

Inventions of groups III, IV and XIII-XV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are drawn to a compound acting as an agonist/antagonist of the activity of a polypeptide, a compound acting as an agonist/antagonist of the activity of polynucleotide, an antibody, a peptide, and a nucleic acid, which are patentably distinct each from the other because they are physically and functionally distinct chemical entities and also have different utilities. For example, peptide or compound can be used as a reagent for in vitro assay, nucleic acid can be used for making probes in northern or southern hybridization, and an antibody can be used for western blotting.

The product of Invention III is distinct from the methods of Invention VII, IX XI and XII because the product of Invention III can be neither made by nor used in the methods of Inventions VII, IX XI and XII.

The product of Invention IV is distinct from the methods of Invention I, II, V, VI, VIII, X and XI because the product of Invention IV can be neither made by nor used in the methods of Inventions I, II, V, VI, VIII, X and XI.

The product of Invention XIII is distinct from the methods of Invention I, II, V, VI, VIII, X and XI because the product of Invention XIII can be neither made by nor used in the methods of Inventions I, II, V, VI, VIII, X and XI.

The product of Invention XIV is distinct from the methods of Invention VII, IX XI and XII because the product of Invention XIV can be neither made by nor used in the methods of Inventions VII, IX XI and XII.

The product of Invention XV is distinct from the methods of Invention I, II, V-X and XII because the product of Invention XV can be neither made by nor used in the methods of Inventions I, II, V-X and XII.

Because the Inventions I-XV are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and their recognized divergent subject matter, and because each invention requires different searches but are not co-extensive, examination of these distinct inventions would pose a serious burden on the examiner and therefore restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement is traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

A telephone call was made to Mark Fitzgerald on September 24, 2003 to request an oral election to the above restriction requirement, but did not result in an election being made.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chih-Min Kam whose telephone number is (703) 308-9437. The examiner can normally be reached on 8.00-4:30, Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low, Ph. D. can be reached on (703) 308-2923. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-0294 for regular communications and (703) 308-4227 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Chih-Min Kam, Ph. D. CMK
Patent Examiner

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September 24, 2003

CHRISTOPHER S. F. LOW
SUPERVISORY PATENT EXAMINER
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